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CHARLES ELMORE JR.

IN THE

Supreme Court of the United States

October Term 1945

No. 137

THE TIMKEN-DETROIT AXLE COMPANY,
Petitioner,

vs.

CLEVELAND STEEL PRODUCTS CORPORATION,
Respondent.

**BRIEF OF RESPONDENT IN OPPOSITION TO
PETITION FOR A WRIT OF CERTIORARI.**

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New York, July 31, 1945.



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Statement of the Case.

This is an ordinary patent suit involving three patents for oil burners, No. 2,039,607 (hereinafter called '607), dated May 5, 1936. Claims 12, 14, 17, and 18 are in issue and will be found in Vol. III, 65-70; No. 2,094,764 (hereinafter called '764), dated August 5, 1937. Claims 1, 9, and 16 are in issue and appear in Vol. III, 81-85; and No. 2,107,800 (hereinafter called '800), dated February 8, 1938. Claim 9 is in issue and appears in Vol. III, 71-79.

All three of the patents in suit relate to oil burners of an old type known as a wall flame burner. District Judge WILKIN found all three of the patents invalid for insufficiency of disclosure and because anticipated by the prior art and for other reasons (Opinion, Vol. II, 1061). The Court

of Appeals (Judge ALLEN) affirmed the lower court in every respect (Opinion, Vol. VI, 2). Both lower courts were clearly right in their findings as a reading of their opinions will show. In arriving at these conclusions, the lower courts followed well-established principles of patent law and correctly applied these principles to the facts of this case. There is therefore no good reason why the petition should be granted.

Counterstatement of Matters Involved.

Contrary to Petitioner's statement, the only contested issue in this case in both courts below was that of validity of the patents in suit. The fact that defendant had a license was conceded, but this license was limited to 200 units for a specific purpose taken while the parties were trying to negotiate a general license arrangement.

Petitioner tries to complicate the case by saying that it involves chemical, physical, fuel combustion and other problems and the solution thereof. The fact is that the patents in suit all relate to simple mechanical arrangements differing if at all from the prior art only in the materials out of which certain parts were made. Petitioner tried to read into the '607 patent a special carbon monoxide flame which was not mentioned in the patent. If there are any physics or chemistry in the case they are the result of this afterthought on the part of Petitioner's attorneys.

Petitioner tries to attribute to the *patents in suit* the contribution which the Court said was made by *Petitioner*. A reading of Judge WILKIN's opinion and that of the Court of Appeals will clearly show that the contribution mentioned was said to have been made by Petitioner and not by the patents in suit.

In quoting from the findings of the District Court, Petitioner carefully avoided quoting Finding 10 reading as follows:

“The improvement over prior art was accomplished by substituting metal for ceramic material and making some adjustments of parts which are mere differences of undefined degree. It merely did better what had been done before.”

The “great contribution” which Petitioner made resided in the substitution of metal for ceramic and for the adjustments mentioned in Finding 10.

Further important facts which Petitioner fails to mention are that there are in operation today as many or more of the old ceramic burners as there are of the metal burners and that Respondent makes and sells six ceramic burners for every metal burner. Respondent makes the metal burner only for those installations where the burner and the boiler are combined into a single unit known as a “packaged job”.

There are no substantial operating advantages of the metal burner over the ceramic burner (R. Vol. I, pp. 410, 413, 414; R. Vol. II, p. 526; R. Vol. I, pp. 473-479).

Under “REASONS RELIED UPON FOR ALLOWANCE OF THE WRIT” (p. 4), Petitioner deserts and abandons the present case entirely and strikes out upon a general theme in the form of a lecture to the Court as to the decline of patents issued in the United States for a certain period of time. Petitioner attributes this decline solely to certain “Conflict and confusion among and between” the District Courts and the Courts of Appeals. There is not a word of testimony in this case even remotely relating to this subject. For all that the record shows, any decline that there might have been in the issuance of patents could have been due to the very unusual and extended depression beginning in 1930.

It is, to say the least, remarkable that this so-called "conflict and confusion" should have begun exactly at the beginning of the depression, as shown by Petitioner's curves opposite page 13. It is too obvious to require argument that such a decline could not be due entirely to the "conflict and confusion" in the courts.

There has been no conflict or confusion between the District Court and Court of Appeals in the present case. On the contrary, they have agreed on the major issue, namely, the invalidity of the three patents in suit.

Any conflict and confusion which may have existed between different courts since 1930 was between holdings of validity and invalidity in different cases where it is to be expected that there will be conflict and perhaps confusion. Such situation, however, is entirely irrelevant to this case because it is obvious that there would be conflict on the broad questions of "Sufficiency of Disclosure" and "Invention or Mechanical Skill" by different courts in different cases. This is for the very simple reason that there has not been found to date any precise and simple rule by which these questions can be resolved in every case.

Petitioner goes so far (p. 21) as to suggest that Judge WILKIN went contrary to his own views in holding the patents in suit invalid, stating that "his decision would have been for the patentees except for these influences".

It is submitted that the decisions below in this case are in complete agreement with prior decisions of this Court where similar questions have been presented on similar facts.

The only "conflict" is that between plaintiff's attorneys on the one hand and the judges of the District Court and Court of Appeals on the other hand. Such "conflict" is not

uncommon but as far as we know has never been held sufficient to grant certiorari.

The Concurrent Findings of the Lower Courts Should Not Be Disturbed.

It is a well established rule of this Court that where there have been concurrent findings of fact by lower courts, such findings will not be disturbed unless it be shown that they are clearly wrong and that there is no substantial evidence to support them. (*Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U. S. 405; *Williams Co. v. Shoe Machine Corp.*, 316 U. S. 364, 367; *Goodyear Co. v. Ray-O-Vac*, 321 U. S. 275, 278; *Universal Oil Co. v. Globe Co.*, 322 U. S. 471, 473.)

Petitioner has made no effort to show that the findings of the courts below of invalidity of the three patents in suit were not fully justified from the evidence in the case.

Petitioner's General Discussion of the Present Day Lot of the Inventing Profession and Decline in the Issuance of Patents Is Wholly Irrelevant and Immaterial.

On pages 9 to 18, inclusive, Petitioner talks in generalities about several matters which to us seem wholly irrelevant and immaterial to any issue in this case. This discussion takes the form of a delicate rebuke of this Court and of lower courts for the failure to sustain more patents. This Court is requested (p. 10) to exercise supervisory authority "not only to still this confusion, but to stay the decline in invention and the disaster, both in peace time industry and in the war weapons, that will result therefrom".

Despite a great deal of argument as to the so-called "conflict and confusion", Petitioner is silent in pointing out to the Court *how* it would be possible to "still this confusion", unless it be by sustaining every patent which is issued by the Patent Office.

It is believed that the lower courts and particularly the patent-experienced Sixth Circuit Court of Appeals understands the standards for determining invention or the lack of it. As we understand the situation, the rules and the procedure by which invention or non-invention is to be determined are no different today than they have been for the last fifty to one hundred years. The difficulty in any case is in the application of the rules to the facts of the particular case. No sane person can deny that when these rules are applied to one set of facts, invention may be found and when applied to another set, non-invention may be found. If this is the confusion about which Petitioner argues, we see no way for the Court "to still this confusion".

The argument on pages 9 to 18 are so remote from any issue in this case that further discussion of it appears to be unnecessary.

Petitioner (p. 19 and elsewhere) tries to disqualify the courts below by showing that the Judges are not scientists. With all due respect, Petitioner's argument relative to the unscientific qualifications of the lower courts applies equally to this Court. Despite this fact, Petitioner asks this Court to "still the confusion" by setting up a hard and fast rule as to what constitutes invention so that the unscientific Judges of the courts below can apply this rule to patents dealing with all phases of scientific subject matter. The burden of Petitioner's argument is that since we have Examiners in the Patent Office who are qualified to deal with the scientific questions presented to them, their decision

should be final and the Courts should sustain every patent that has been granted by the Patent Office. The difficulty with this argument is that even if the Court felt disposed to attempt to work out a rule which would allow every patent to stand, it would be in direct conflict with the statutes and would be invalid. Petitioner's efforts here should be directed to the Congress for a change in the statutes respecting all grounds upon which the validity of a patent could be attacked. This, of course, would involve a complete revamping of the entire patent system, including the Patent Office.

Petitioner gives the impression that nothing was before the Court that was not before the Patent Office. This is grossly misleading and incorrect.

Petitioner fails to point out that the Court heard testimony from experts on both sides. He had the advantage of much more evidence than was before the Examiner in the Patent Office. The Examiner's conclusions are based on an *ex parte* proceeding. It makes no difference that the '607 patent was in interference because this suit is not between the parties to the interferenee and the interference was decided without any contest on the question of patentability. *Bohn Aluminum & Brass Corp. v. Berry*, 124 F. (2d) 865, 867, 870 (C. C. A. 6).

Another important matter which was before the Court and not before the Patent Office was the cross examination of Mr. Powers. Still another important matter was the testimony of Mr. O'Brien. A fourth important matter was the Bird prior use. As to this, Judge ALLEN stated (Vol. VI, p. 12):

"More important than the claimed anticipation of the Bird patent we think is the fact of the Bird prior use. It is clearly established by disinterested wit-

nesses, memoranda, drawings and correspondence that Bird in 1925 built and used wall-flame burners equipped with an impingement rim of sheet metal. One was installed at the Bird house, one at the plant and two were sold. The rim was spaced a couple of inches from the wall of the water leg of the boiler."

The next sentence at this page of the record was corrected (see Vol. VI, p. 57) to read:

"This operation clearly constitutes a prior use, invalidating claims 12, 14, 17 and 18 of patent 2,039,607."

The sufficiency of disclosure is a purely legal question as to whether or not the revised statutes have been complied with. While the Patent Office Examiners may be versed as scientists, they are not particularly qualified as lawyers, some of them not having studied law at all. Since the Judges of the lower courts and of this Honorable Court have had exceptional training in the law, their judgment on legal questions is as far above that of the Examiner as Petitioner would have the Examiner's opinion above that of the Judges on scientific questions. The courts below concurred in finding that the disclosures of the three patents in suit were insufficient and we believe that this Court will agree, because the present case is strikingly similar in this respect to *General Electric Co. v. Wabash*, 304 U. S. 364 and *United Carbon Co. v. Binney & Smith*, 317 U. S. 228, cases.

Thus we see that even on the scientific questions, there was a great deal of testimony and other evidence before the lower courts which was not before the Patent Office Examiner and who knows but that he would have agreed with the Courts if the same facts had been before him. As to the sufficiency of the disclosure from a legal viewpoint and applying Petitioner's own reasoning, the opinions of the

lower courts stand far above that of the Examiner on this legal question.

Invention and Mechanical Skill.

Under this heading (p. 21), Petitioner tries to show that Judge WILKIN attributed a great contribution to the patentees in suit. He did no such thing, as will be clear from a reading of his opinion. Closely following Petitioner's quotation, Judge WILKIN said (Vol. II, p. 1064):

"Yet when the specific question arises: What is the invention, what is its essence, its limits, and how is it defined, there is no adequate answer. After consideration of all the evidence and all the arguments the court finds no difference between what the plaintiff did and what was formerly done, except a change of material and the inherent mechanical variations occasioned by such changes. The improvement over prior art was accomplished by substituting metal for ceramic material and making some adjustments of parts, which are mere differences of undefined degree."

Mr. Powers, the inventor of two of the patents in suit and Petitioner's expert at the trial, admitted (Vol. I, pp. 282, 287) that every element of claim 12 of patent '607 was old in the prior art except the spaced "thin fuel vaporizing wall of high heat conductivity". The Heath patent discloses every element of every claim in suit with the single exception that the Heath construction is ceramic, whereas those of the patents in suit are of metal or other material of high heat conductivity. There is abundant evidence to support this statement. The very first entry in Powers' notebook (PX-95, Vol. III, p. 375) under date of February 23, 1932, states:

"Continuing work on *substitution** of metallic hearth tile in place of present refractory tile * * *."

In a memorandum (PX-96, Vol. III, p. 389) prepared by Powers and sent with his letter of March 16, 1932 to his patent attorneys, Powers stated (p. 393):

"Quite some time ago a metal hearth construction was developed as a *substitute* for the present refractory hearth bed. It was my plan to *substitute* metallic segments and a metallic hearth in place of the present refractory hearth bed and refractory segments".

When the Heath Patent 1,886,675 (Vol. IV, p. 721) is clearly understood and when it is remembered that at the time Powers developed his devices, the Petitioner owned the Heath patent, it will be evident that the substitution to which Powers made such frequent reference was substituting metal for the ceramic parts of the Heath burner.

There was nothing even novel in the use of metal in an oil burner because that is clearly shown and described in the Bird Patent 1,671,340 (Vol. IV, p. 705).

Petitioner argues (p. 24) that the District Court found it necessary to take a part from here and a part from there to anticipate the claims. This is not true. Judge WILKIN said (Vol. II, p. 1064):

"Its patents† are anticipated by Heath, 1,886,675, Bird, 1,671,340, and Kolva, 1,381,092."

The Court of Appeals quotes at length from an interference record to which Powers was a party (Vol. VI, p. 7). From this it is clear that Powers regarded Heath as disclosing everything except "metal". The Court of Appeals (Vol. VI, p. 11) states:

* All emphasis ours unless otherwise stated.

† It should be remembered that there are three patents in suit.

"Furthermore, this patent * is anticipated by Heath, 1,886,675, which, as stated by Powers in the interference proceedings, is for a wall-flame burner. Heath discloses all of the mechanical elements of the Powers claims, and Powers, with some hesitation, concedes this, stating that the difference is in the functioning. But the Heath burner functions in substantially the same manner as Powers."

This should be all that is necessary to show that Petitioner is in error in arguing that it was necessary for the Court in anticipating Powers to take parts from numerous sources.

The above remarks quoted from the opinion of the Court of Appeals related to the '607 patent. The only difference between that patent and Wilson '764 is that Wilson placed metal grills on the top of the flame rim. Heath clearly discloses grills and fully points out their function so that here again Wilson merely substituted metal for ceramic in so far as the grills were concerned.

The only material difference between Powers '607 patent and the Powers '800 patent is that the '800 patent has two rims, one for deflecting the air and the other as a flame rim. Heath had an air deflecting rim made of ceramic, but it functioned in exactly the same way as the Powers metal rim and therefore we have again merely the substitution of metal for ceramic.

Sufficiency of Disclosure.

In urging this defense in both courts below, we relied upon two decisions by this Court, namely, *General Electric Co. v. Wabash*, 304 U. S. 364, and *United Carbon v. Binney & Smith*, 317 U. S. 228.

* Patent '607.

The main evidence in support of this contention is that of Mr. Powers himself. It is quite clear from the '607 patent that whatever advantages are claimed for it are attributed to the thinness of the metal flame rim. It is equally evident that the patent nowhere gives any information as to how thin the rim must be. On cross examination (Vol. I, p. 263) Mr. Powers said that to gain the advantages the preferred thickness of the rim was .025 of an inch and that as this thickness was gradually increased the supposed advantages gradually disappear and that there would come a time (at about $\frac{3}{8}$ to $\frac{1}{2}$ inch) when the supposed advantages would completely disappear. He also admitted that this change, with the change in thickness, was a mere matter of degree and that there was no thickness at which there would be any kind of a critical change. Also (Vol. I, p. 266) that different materials, including metals, have different heat conductivities and that experimentation would be required for each material to determine its effective thickness. And despite the fact that cast iron is a metal and has a high heat conductivity it would not be suitable for an impingement rim (Vol. I, p. 263).

When the claims are examined it will be found that the rim is defined in very broad and general language, such as "thin", "thin sheet metal" and other similar expressions.

Petitioner tries to find sufficient disclosure by stating that the drawings of the patent are to scale. There is no statement in the patent that they are to scale.

Petitioner (p. 29) tries to show that anyone with a ruler can determine the thickness of the rim, but there is no basis for this contention. In fact the dimensions that are given in the patent do not agree. It is stated that the wall 8 in patent '607 is three or four inches from the boiler wall and that the distance *I* is about two inches. Looking at the patent drawings, the distance of the rim 8 from the boiler

wall is $\frac{3}{4}$ of an inch. If this represents three inches, then one inch on the drawing is equal to four inches. If this distance is four inches, then one inch on the drawings equals $5\frac{1}{3}$ inches.

Taking the other measurement, the distance I on the drawings is $11/16$ of an inch and if this represents two inches then one inch on the drawing equals three inches. From these calculations, using the patent drawings, we find three different values per unit or three different scales. The fact that no one of these measurements agrees with any other is conclusive proof that the drawings are not to scale.

The mere fact that the patent mentions sheet metal is of no help because Powers admitted (Vol. I, p. 279) that armor plate is sheet metal and it is well known that armor plate may be several inches thick and usually is.

In a situation like the present where whatever novelty there is depends upon the *thinness* of the flame rim, it is clear that the statute requires a definite and specific disclosure of that feature. Furthermore, the claims should be definite in order that others may know what infringes and what does not. Such a general and indefinite disclosure as we find in these patents is far below the requirements of the statutes and the patents are invalid for that reason, as both lower courts found them to be.

***Sinclair & Carroll v. Interchemical Corporation*
Is Not Helpful to Petitioner.**

Petitioner argues that this Court has changed its formula for invention by the *Interchemical* case, quoting from the decision as follows:

“Consequently it is not concerned with the quality of the inventor’s mind, but with the quality of his product.”

Immediately following Petitioner's quotation, this Court said:

"The patent in suit was not the product of long and difficult experimentation."

There is not a word of evidence in the present case that either Powers or Wilson did any experimentation whatsoever. For all that the record shows, Powers merely shaped a piece of metal to correspond with the face of the old ceramic segment and made up a ring of such segments, and used it with the other necessary parts, such as those used in a Heath burner. There was no special demand for any such change and no particular advantage from an operating standpoint in such change. So far as the record shows, Powers was not even requested by anyone to make the new burner, but either out of curiosity or for some other reason decided to substitute metal for the ceramic.

Petitioner admits (p. 35) that there was no flash of genius in the present case, but tries to spell out of Judge WILKIN's decision that there was some innovation that differentiated it from the prior art. As we have already explained, Judge WILKIN never said that there was any innovation in the *patents in suit*, nor did he say that the *patents* made any contribution to the art. In fact, after saying that *Petitioner* made a contribution, Judge WILKIN said that

"Yet when the specific question arises: What is the invention, what is its essence, its limits, and how is it defined there is no adequate answer."

Certainly, if Judge WILKIN could not find from the patents what the inventions were, he would not and could not say that the inventions which he could not find made a great contribution. As a matter of fact, there was no innovation and certainly none for which society is truly indebted to

the efforts of the patentees, as stated in the *Interchemical* case.

The record in this case shows that the ceramic burner was just as good as the metal burner in every respect in so far as the user was concerned and therefore neither society nor the public has been benefited materially by any contribution made by the patents in suit.

There is no difficulty whatever in the present case in applying the old established rule for determining the presence or absence of invention.

These patents are clearly insufficient in their disclosure, as settled by many cases, including the *Wabash*, *United Carbon*, and *Interchemical* cases. There is lack of invention because (1) the change is a mere matter of degree; (2) an attempt is made to re patent an old combination by improving one element thereof; (3) nothing is involved but a mere substitution of metal for ceramic and (4) the claims are invalid because anticipated.

Conclusion.

It is respectfully submitted that the petition should be denied.

New York, July 31, 1945.

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